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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,041

12/14/2005

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08/25/2008

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EXAMINER

GILLESPIE, BENJAMIN

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Note

Continuation of Section 11: Applicants argue the claimed invention is patentable over the prior art because the rejections of:

- a) claims 1-6, 8-9, 15-18, 20-22, and 24 as being unpatentable over English,
- b) claim 23 as being unpatentable over English in view of Bennett,
- c) claims 1-9, 13-22, and 24 as being unpatentable over Lipatova in view of English and Ueyanagi,

Are based on combinations set forth by the examiner which lack prima facie obviousness. In particular, applicants argue the prior art fail to teach certain critical aspects, or instead teach away from each other and as a result one of ordinary skill would not be motivated to combine the teachings of the prior art.

Regarding issue a), applicants state that claims 1-6, 8-9, 15-18, 20-22, and 24 is not obvious in view of English since patentee does not teach a combination of BOTH di and tri functional polyisocyanate; instead applicants assert the examiner has relied upon impermissible hindsight in combining the di and tri functional compounds. In response, the examiner would point out that applicants have appeared to ignore the motivation set forth in paragraph 2 of the final rejection mailed 6/17/2008. The examiner never relied upon motivation gleaned from applicants' specification, but instead applied the established prima facie case of obviousness based on *In re Kerkhoven*, 205 USPQ 1069, which states that two components can be combined in order to form a third composition that is to be useful for the same application. Applicants' have not addressed this, and therefore the examiner maintains his position.

Concerning issue **b)**, applicants argue that it would not have been obvious to include the teachings of Bennett in English since Bennett fails to teach a composition having all three claimed reactants. The examiner acknowledges the fact that Bennett does not teach all three reactants, if patentee did the claimed invention would be rejection under 102(b), not 103(a). Furthermore, the prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. *In re Merck & co. Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). With this understanding it is noted that the compositions of English and Bennett are not identical to the claimed invention, however both teach bio-adhesives based on the reaction product of bio-absorbable oligomeric esters and polyisocyanates, therefore one of ordinary skill would reasonably expect success when utilizing the reaction conditions of Bennett in English.

Finally, regarding **c)** applicants again state that it would not have been obvious to combine the teachings of the prior art because Lipatova et al fail to teach the claimed composition and instead the composition of Lipatova et al is not disclosed as “bioabsorbable.” Again the examiner would like to state that the prior art was not presented as being anticipated under 102(b), and instead should be considered as the examiner applied it, i.e. Lipatova et al **in view of** English and Ueyanagi et al. Furthermore, contrary to applicants' assertions, Lipatova et al teach the composition is useful as an adhesive which “is quickly intergrown with live tissue and eliminated from the body.” It is the examiner’s position that disclosure equates to a bioabsorbable polymer.

Moreover, applicants argue that the examiner has erred in including the teachings of Ueyanagi since Ueyanagi does not teach an analogous composition or applications in

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bioabsorbable adhesives. In reply, the examiner notes applicants' remarks, however the determination that a reference is from a nonanalogous art is twofold. First it is decided if the reference is within the field of the inventor's endeavor. If it is not, then it must be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174; *In re Clay*, 23 USPQ.2d 1058.

Although, it is noted that Ueyanagi et al do not teach bioabsorbable adhesives, the teachings of Ueyanagi et al are still pertinent to the other prior art since the relied upon subject material teach the user how to reduced solvent content in adhesives. This is pertinent the particular problems of Lipatova et al and English since both are drawn to adhesives that are to be used with living tissue. As previously stated in paragraph 11 of the final rejection mailed 6/17/2008, by reducing the amount of required solvent, the resulting composition is less toxic which is desired in bio-medical applications.

/Rabon Sergent/
Primary Examiner, Art Unit 1796